

II. Remarks

The Examiner is requested to reconsider the application. It is believed that no new matter has been added by the amendment.

In the Office Action mailed April 28, 2009, claims 1-4, 35-42, 48, 57-64, 70-84, 115-122, 128, 137-144, 150-161 have been deemed generic, and Examiner has issued an election/restriction requirement according to Groups A-F with numerous subgroups, as set out in the Office Action. The Examiner has required that "one species from each group may be elected for examination."

In response, Applicant elects Groups A1 (claims 5, 85), B1 (claims 43, 123), C3 (claims 51, 131), D1 (claims 52, 132), E1 (claims 65, 145), and F2 (claims 162, 166) with traverse. Respectfully, the requirement is believed to be improper, and reconsideration is respectfully requested.

First, the Examiner has contended, at page 7 of the Office Action, that the "species are independent or distinct because claims to the different species recite mutually exclusive characteristics of such species." The burden is on the PTO to establish species, and the mere above-quoted contention is not sufficient to distinguish species from dependent claims which are not species, and not sufficient to distinguish each particular specie from any other specie. The Examiner has not met the PTO burden, and the requirement is improper.

Second, pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has been denied this entitlement, based upon the manner in which the requirement has been set forth. In view of Sec. 132 and Rule 104, the PTO is required to provide not only the

reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*” and no such information has been provided. The requirement is therefore improper under Sec. 132 and Rule 104.

Third, even if the claims are established as “separate and distinct,” there is “a serious burden on the Examiner if restriction is required (see MPEP Section 803.02, Section 806.04(a) - Section 806.04(i), Section 808.01(a), and Section 808.02).” And pursuant to GUIDELINES found there, “examiners must provide reasons and/or examples to support conclusions.” The Examiner has not provided sufficient “reasons and/or examples to support conclusions” as required by the MPEP. The Examiner contends that

“There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one of the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.”

Applicant respectfully submits that this is a mere boilerplate that has not been applied so as to establish that there is any particular burden with respect to any particular specie. This being a PTO burden, the Examiner is required to apply, not merely copy in an MPEP section, to each particular specie. It is not apparent from the record, nor can Applicant see, how “the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.” The Examiner’s explanation is required as to any particular species where the Examiner believes the contention to be true. It seems that the contention of “searching different classes/subclasses” cannot be correct in that no class or subclass has been associated with the alleged species, and one might imagine that the class and subclasses would be similar and searched as a matter of course in a quality examination. It is believed to be routine to use “different search queries” with respect dependent claims, and this alone does not establish a burden, nor does the use of different electronic resources. More so, Applicant

disputes that a proper PTO prior art search for the elected specie will not include a search of the art of any other specie, and if the Examiner disagrees, then Applicant requires the Examiner's declaration or affidavit to establish the fact. In any case, the Examiner's evidence, declaration, or affidavit is hereby required to establish veracity of what otherwise appears to be mere contention of a serious burden, the contention having no apparent application to each of the alleged species. Further this *information* is also required pursuant to Sec. 132 and Rule 104. The restriction is therefore improper.

Fourth, MPEP Sec. 803 states "If the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions." The MPEP also requires consideration of linking claims. In the Office Action, no consideration has been shown as to linking claims of the contended species, and further this *information* is also required pursuant to Sec. 132 and Rule 104. The restriction is therefore improper.

Applicant requests an Examiner Interview prior to the next Office Action.

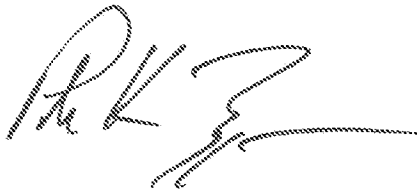
With respect to the present application, the Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

The application is believed to be in condition for allowance, and favorable action is requested. If the prosecution of this case can be in any way advanced by a telephone discussion, the Examiner is requested to call the undersigned at (312) 240-0824.

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed, this shall be deemed a petition therefor.

Please direct all communication to the undersigned at the address given below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'P. Trzyna', with a long horizontal flourish extending to the right.

Date: October 28, 2009

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